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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,906	01/25/2001	Matthew Bruce Tropper		5001

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Matthew B. Tropper
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Plainview, NY 11803

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 09/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,906

Applicant(s)

TROPPER, MATTHEW BRUCE

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant amended claims 1-2 and 4, canceled claims 3 and 5-15, and added claimed 16-22. The pending claims are 1-2, 4 and 16-22. Claims 1-2 and 4 have been reconsidered by examiner, however, the claims still could not be defined over the Rivette reference as the following action. In addition, the claim for domestic priority under 35 U.S.C 119 (e) (to a provisional application) is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-2, 4 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. [USP 6,339,767 B1].**

Regarding to claim 1, Rivette teaches a method of maintaining databases of patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Col. 17, line 16-Col. 23, line 25). As shown in Fig. 86, the patent citation module 1004 operates to identify, for a particular source patent as *a patent under test*, the patents which were cited during

the prosecution of the selected patent are called citing patents. In step 8606, the patent citation module 1004 receives information from the requesting client 304, 306 that identifies one or more BOM groups. BOM group database is a group that contains patents that map to a product, or parts of a product. In step 8608, the patent citation module 1004 identifies the patents, which are mapped to the BOM groups corresponding to the BOM_ids identified in step 8606. In step 8610, the patent citation module 1004 identifies the patents that are cited in the patents identified in step 8608 by reference to the PatentRef table 1208. In step 8610, the patent citation module 1004 forwards the results to the requesting client 304, 306 (Col. 87, lines 4-58; Col. 21, line 64-Col. 22, line 4). As seen, the database 316 is search by using PatentRef table to identify and store in a result list the cited patents of a particular source patent. In other words, this technique performs the claimed *searching the database and storing as first generation data identifying data corresponding to at least one patent in the database which is cited in the patent under test*. Rivette does not explicitly teach the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which is cited in at least one patent identified by the first generation data; and operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test*. However, as disclosed by Rivette at step 8612 in Fig. 86, the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth. As shown in Fig. 65 is the display of a recursive patent citation function. In Fig. 65, patent 1 is the source patent, and patents 2-4 are cited in patent 1. The patent citation report of Fig. 65 is

multi-leveled. Accordingly, the display format of Fig. 65 indicates that patents 5-8 are cited in patent 2, patent 9 is cited in patent 3, and patents 10-12 are cited in patent 4. The format 6502 as in Fig. 65 is a two level patent citation report and can be any operator specified level. Other display formats could be used by the invention to more effectively display the results of multi-level patent citation reports, such as the well-known Xerox hyperbolic tree display format. The patent citation module 1004 collects data for a multi-level patent citation report by repetitively performing the steps of flowchart 8602 (Col. 88, line 65-Col. 89, line 21). As seen, by specifying a level at step 8612, the database 316 is searched again to identify and store citing patents corresponding to the cited patents of the result of step 8610 in a tree displaying format, or in other words, *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which is cited in at least one patent identified by the first generation data*, and the Xerox hyperbolic tree displaying of the recursive patent citation function as shown in Fig. 65 indicates the step of *operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test*. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by including the step of searching the database and storing as second generation data, operating on second generation data to identify patents in order to retrieve the cited patents in a particular source patent.

Regarding to claim 2, Rivette teaches all the claimed subject matters as discussed in claim 1, and further discloses the step of *receiving from a user an identification of the patent under test* (Fig. 89).

Regarding to claim 4, Rivette teaches all the claimed subject matters as discussed in claim 1, and further discloses the step of *displaying at least the operated-on second generation data to a user* (Fig. 65).

Regarding to claim 16, Rivette teaches all the claimed subject matters as discussed in claim 4, and further discloses the step of *displaying both the operated-on second generation data and the first generation data to the user* (Col. 87, line 59-Col. 89, line 21).

Regarding to claim 17, Rivette teaches all the claimed subject matters as discussed in claim 1, and further discloses one of the steps *(a) storing as first generation data identifying data corresponding to each patent in the database which is cited in the patent under test; (b) storing as second generation data identifying data corresponding to each patent in the database which is cited in each patent identified by the first generation data; and (c) operating on the second generation data to identify or filter out each patent identified in the second generation data that is cited in the patent under test* (Fig. 86, Col. 87, lines 4-58).

Regarding to claim 18, Rivette teaches a method of maintaining databases of

patents. As shown in Fig. 6 is the databases 316, which store patent information, and information pertinent to the analysis of the document information (Col. 17, line 16-Col. 23, line 25). As shown in Fig. 86, the patent citation module 1004 operates to identify, for a particular source patent as *a patent under test*, the patents which were cited during the prosecution of the selected patent are called citing patents. In step 8606, the patent citation module 1004 receives information from the requesting client 304, 306 that identifies one or more BOM groups. BOM group database is a group that contains patents that map to a product, or parts of a product. In step 8608, the patent citation module 1004 identifies the patents, which are mapped to the BOM groups corresponding to the BOM_ids identified in step 8606. In step 8610, the patent citation module 1004 identifies the patents that are cited in the patents identified in step 8608 by reference to the PatentRef table 1208. In step 8610, the patent citation module 1004 forwards the results to the requesting client 304, 306 (Col. 87, lines 4-58; Col. 21, line 64-Col. 22, line 4). As seen, the database 316 is search by using PatentRef table to identify and store in a result list the cited patents of a particular source patent. In other words, this technique performs the claimed *searching the database and storing as first generation data identifying data corresponding to at least one patent in the database which is cited in the patent under test*. Rivette does not explicitly teach the step of *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data; and operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test*. However, as

disclosed by Rivette, the patent citation module 1004 also performs a forward citation function by identifying, for a source patent, the patents in which the source patent was cited (Col. 87, lines 10-15). As shown in step 8708 of Fig. 87, the patent citation module 1004 identifies the patents by conducting a search in the BOM_patent_xref table 1218 using the BOM_ids. In step 8710, the patent citation module 1004 determines the patents that cite the patents identified in step 8708. The patent citation module 1004 forwards the results of the above operation to the client analysis module 716 in the requesting client 304, 306. In step 8712, the client analysis module 716 displays this information received from the patent citation module 1004 on the client display monitor 1122. The client analysis module 716 displays this information to the operator in any one of a number of display formats as shown in Fig. 61-65 (Col. 89, lines 22-53). As seen, instead of using the identified patents of step 8708, the identified patents result of backward search in step 8610 could be used to determine the patents that cite these identified patents to perform the claimed *searching the database and storing as second generation data identifying data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data*. The result then is forwarded to the client for displaying in a particular format as in Fig. 61-65 of step 8712 as *operating on the second generation data to identify or filter out at least one patent identified in the second generation data that is cited in the patent under test*. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rivette method by including the step of searching the database and storing

as second generation data, operating on second generation data to identify patents in order to retrieve the citing patents of the cited patents in a particular source patent.

Regarding to claim 19, Rivette teaches all the claimed subject matters as discussed in claim 18, and further discloses the step of *receiving from a user an identification of the patent under test* (Fig. 89).

Regarding to claim 20, Rivette teaches all the claimed subject matters as discussed in claim 18, and further discloses the step of *displaying at least the operated-on second generation data to a user* (Fig. 65).

Regarding to claim 21, Rivette teaches all the claimed subject matters as discussed in claim 20, and further discloses the step of *displaying both the operated-on second generation data and the first generation data to the user* (Col. 87, line 59-Col. 89, line 21).

Regarding to claim 22, Rivette teaches all the claimed subject matters as discussed in claim 18, and further discloses one of the steps *(a) storing as first generation data identifying data corresponding to each patent in the database which is cited in the patent under test; (b) storing as second generation data identifying data corresponding to each patent in the database which is cited in each patent identified by the first generation data; and (c) operating on the second generation data to identify or filter out each patent identified*

in the second generation data that is cited in the patent under test (Fig. 86, Col. 87, lines 4-58).

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 703-605-4242. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM Y VU can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2172

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Hung Pham
August 14, 2003



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER